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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/610,158
Filing Date: June 30, 2000
Appellant(s): VEENEMAN ET AL.

James M. Graziano
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/05/2009 appealing from the Office action mailed 07/09/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

Claim Rejections of Claims 9-14 under 35 U.S.C. 103(a) as being unpatentable over Chain Store Age in view of Parent.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Here Comes The (New) Bridal Registry,
Chain Store Age Executive

October 1992

US 5,113,496

McCalley et al.

May 12, 1992

Electronic Shopping Markets:
The Retail Connection;

Brumback et al.

October 31, 1983

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Remarks

Method Claim 13 (lines 8-9) recites the following step (emphasis added): "using the portable input and storage device to select desired gifts from a plurality of participating merchants;". For the purposes of prosecution the examiner understands said phrase as: "using the portable input and storage device to select desired gifts from the plurality of participating merchants;".

Improper Recapture

Claims 9-12 are rejected under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir 1997); *Ball Corp. V United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984), A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Applicant's broadening of the claims has been considered in light of the prosecution of the parent cases and is seen to be improper recapture. Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas. Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Millerv. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 9-14 of this application conflict with claims 1-8, 15-29 of Application No. 10/940,094. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Here Comes The (New) Bridal Registry; Chain Store Age Executive, October 1992 (Chain Store Age) in view of McCalley et al. (US 5,113,496).

As per Claim 9, 13.

Chain Store Age, which appears to be published in October 1992 (See bottom of the first page), discloses:

a gift registry computer system containing identifying information about a registrant, the information for each registrant including at least the registrant's name and a list of potential gifts which the registrant has identified (page 1 lines 51 - page 2 column 1, line 10);

a portable input and storage device for use by the registrant with a plurality of potential gifts, the input and storage device being capable of receiving and storing information regarding the registrant's desired (page 2 column 1, lines 3-10 and lines 41-48);

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system (page 2 column 1, lines 6-10);

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from(page 2 column 3, lines 14-21).

While Chain Store Age discloses entering a unique identifier for each gift (the collection of SKU numbers), which can be specific to the merchant and in the case of a store brand and therefore identified with the merchant, just as the bride can scan a generic code, (page 2, column 1, lines 41-49), Chain Store Age does not specifically disclose that said unique identifier includes said specific to the merchant unique identifier (associated with the particular merchant) having each of the gifts.

McCalley et al ('496) teaches a system that provides customers with online shopping and gift registry in the electronic mall, (column 22, lines 1-16) for the benefit

of increased customer satisfaction and convenience. Specifically, McCalley et al teaches providing a personal directory for keeping customized list of items (gifts) which cross store boundaries, and providing a bridal registry server maintained on a mall-wide basis (C. 22, L. 5-6, 10-11), thereby suggesting associating said items (gifts) with a corresponding store on a mall-wide basis and providing said unique to the merchant identifier.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chain Store Age, to store and display gift registry associated with different merchants, and to enter said specific (unique) to the merchant identifier, as suggested by McCalley et al ('496) because it would advantageously provide subscribers with the ability to easily find products in a particular store, as specifically stated in McCalley et al ('496) (C. 22, L. 12-14), thereby increasing customer satisfaction and convenience.

As per Claim 10

Chain Store Age further discloses the portable device is a hand-held scanning device, see page 2, column 1, lines 4-5.

As per Claims 12, 14.

Chain Store Age further discloses an updating means for updating the database storage registrant as a prospective purchaser buys a gift from the list of potential gifts for a potential registrant, see page 2, column 1, lines 49-57.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chain Store Age in view of Brumback et al. (Electronic Shopping Markets: The Retail Connection; October 31, 1983).

As per Claims 9, 13,

Chain Store Age discloses:

a gift registry computer system containing identifying information about a registrant, the information for each registrant including at least the registrant's name and a list of potential gifts which the registrant has identified (page 1 lines 51 - page 2 column 1, line 10);

a portable input and storage device for use by the registrant with a plurality of potential gifts, the input and storage device being capable of receiving and storing information regarding the registrant's desired (page 2 column 1, lines 3-10 and lines 41-48);

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system (page 2 column 1, lines 6-10);

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from(page 2 column 3, lines 14-21).

While Chain Store Age discloses entering a unique identifier for each gift (the collection of SKU numbers), which can be specific to the merchant and in the case of a store brand and therefore identified with the merchant, just as the bride can scan a generic code, (page 2, column 1, lines 41-49), Chain Store Age does not specifically disclose that said unique identifier includes said specific to the merchant unique identifier (associated with the particular merchant) having each of the gifts.

Brumback et al teaches a system that provides customers with gift suggestions from several stores in the mall, (see page 1, column 2, 7th paragraph) for the benefit of increased customer satisfaction and convenience. Specifically, Brumback et al. teaches: "Shoppers, by touching a TV screen in a kiosk in the mall can ask a computerized directory, for example, for a list of gifts for a small boy who likes sports. Suggestions from several stores in the mall flash on the screen. Once customers pick a gift, they can ask the computer how to find the store in the three-level complex. Instantly, a map and directions from the kiosk appear on the screen", which indicates associating said gifts

with a corresponding store in the mall (complex) and thereby suggests providing said unique to the merchant identifier.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chain Store Age, to include storing and displaying gift registry associated with different merchants, and entering said specific (unique) to the merchant identifier, as suggested by Brumback et al, because it would advantageously provide subscribers with the ability to easily find a specific product and a particular store, as specifically stated in Brumback et al, thereby increasing customer satisfaction and convenience.

As per Claim 10

Chain Store Age further-discloses the portable device is a hand-held scanning device, see page 2, column 1, lines 4-5.

As per Claims 12, 14.

Chain Store Age further discloses an updating means for updating the database storage registrant as a prospective purchaser buys a gift from the list of potential gifts for a potential registrant, see page 2, column 1, lines 49-57.

(10) Response to Argument

(10.01)

Applicant argues that Improper Recapture of claims 9-12 under 35 U.S.C. 251 should be withdrawn because the claims presented in the reissue application do not impermissibly recapture canceled subject matter.

In response to this argument the examiner maintains that a broadening aspect is present in the current reissue which was not present in the application for a patent. The

record of the application for the patent shows that the broadening aspect (in the current reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Specifically, Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas. Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture. (See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement* 131 F.3d 1464, 45 Uspq2d 1161 (Fed. Cir 1997); *Ball Corp. V United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

(10.02)

Applicant argues that the Chain Store Age system does not store merchant identification information.

In response to this argument the examiner points out that McCalley et al was applied for this feature. Specifically, McCalley et al teaches providing a personal directory for keeping customized list of items (gifts) which cross store boundaries, and providing a bridal registry server maintained on a mall-wide basis (C. 22, L. 5-6, 10-11), thereby suggesting associating said items (gifts) with a corresponding store on a mall-wide basis and providing said unique to the merchant identifier. McCalley et al teaches that said personal directory for keeping customized list of items (gifts) which cross store boundaries allows to easily find products in a particular store (C. 22, L. 12-14), thereby suggesting providing said unique store/merchant identifier in order to find said store.

(10.03)

Applicant argues that the Chain Store Age system is devoid of even a hint of multiple merchants, since the system is exclusively single merchant-centric and not extensible to multiple merchants, and that the concept of multiple merchants is contrary to all aspects of the teachings of the Chain Store Age article.

In response to this argument it is noted that the Chain Store Age discloses a system wherein a portable scanner is used to obtain product information by scanning a specific/ unique code of the product (Page 2, lines 41-43). The Chain Store Age further teaches that instead, or in addition, the bride can scan in a generic code for the product (bath towels) (Page 2, lines 43-45). In this example the only difference is in content of the code. Accordingly, said content may as well include merchant identification information for the benefit of reordering the sold out item or inquiring for custom modification. There is no change in technology required; all what is need is additional data or content. Furthermore, the "concept of multiple merchants" feature was addressed in McCalley et al, which discloses providing a personal directory for keeping customized list of items (gifts) which cross store boundaries, and providing a bridal registry server maintained on a mall-wide basis (C. 22, L. 5-6, 10-11).

(10.04)

Applicant argues that there is no suggestion in the McCalley to provide a unified database of gift registry information.

In response to this argument it is noted that the Chain Store Age discloses this feature (See a discussion above). To this end Examiner points out that Applicant's arguments are directed against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(10.05)

Applicant argues that McCalley does not teach that the data entries are distinguished by a "unique identifier associated with the particular merchant having each of the desired gifts".

In response to this argument the Examiner maintains that McCalley et al suggests this feature. Specifically, McCalley et al teaches providing a personal directory for keeping customized list of items (gifts) which cross store boundaries, and providing a bridal registry server maintained on a mall-wide basis (C. 22, L. 5-6, 10-11), thereby suggesting associating said items (gifts) with a corresponding store on a mall-wide basis and providing said unique to the merchant identifier. McCalley et al teaches that said personal directory for keeping customized list of items (gifts) which cross store boundaries allows to easily find products in a particular store (C. 22, L. 12-14), thereby suggesting providing said unique store/merchant identifier in order to find said store.

(10.06)

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this particular case both references relate to the same application field, and disclose a system for obtaining product information by using a portable scanner. The motivation to modify the reference would be the advantage of providing the subscribers with the ability to easily find products in a particular store, as specifically stated in McCalley et al ('496) (C. 22, L. 12-14), thereby increasing customer satisfaction and convenience.

(10.07)

Applicant argues that there is no suggestion in the Brumback Publication to provide a unified database of gift registry information.

In response to this argument it is noted that the Chain Store Age discloses this feature (See the discussion above). To this end Examiner points out that Applicant's arguments are directed against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(10.08)

Applicant argues that McCalley and Brumback does not teach that the data entries are distinguished by a "unique identifier associated with the particular merchant having each of the desired gifts".

In response to this argument it is noted, that Brumback et al teaches a system that provides customers with gift suggestions from several stores in the mall, (see page 1, column 2, 7th paragraph). Specifically, Brumback et al. teaches: "Shoppers, by touching a TV screen in a kiosk in the mall can ask a computerized directory, for example, for a list of gifts for a small boy who likes sports. Suggestions from several stores in the mall flash on the screen. Once customers pick a gift, they can ask the computer how to find the store in the three-level complex. Instantly, a map and directions from the kiosk appear on the screen", which indicates associating said gifts with a corresponding store in the mall (complex) and thereby suggests providing said unique to the merchant identifier.

(10.09)

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this particular case both references relate to the same application field, and disclose a system for obtaining product information by using a portable scanner. The motivation to modify the reference would be the advantage of providing subscribers with the ability to easily find a specific product and a particular store, as specifically stated in Brumback et al, thereby increasing customer satisfaction and convenience.

(10.10)

Claim Rejections of Claims 9-14 under 35 U.S.C. 103(a) as being unpatentable over Chain Store Age in view of Parent have been withdrawn. Therefore, Applicant's arguments regarding said Claim Rejections moot.

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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